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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,245	08/21/2002	Toshihiro Sadaoka	50069-11	4541
20277	7590	11/17/2005		
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER CHOI, FRANK I	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,245

Applicant(s)

SADAOKA ET AL.

Examiner

Frank I. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. See MPEP Section 2171. Evidence that claims 1-3 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the Appeal Brief (12/15/2004). In that paper, applicant has stated “claim 1 recites that the paper is selectively capable of absorbing oxidized sebum. In interpreting this phrase in light of the plain meaning of the terms used therein and in view of the specification, this limitation is directed to the concept that the paper is selectively absorbing oxidized sebum from other types of sebum” (Appeal Brief (12/15/2004), Pgs. 10, 11), and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not include the limitation “from other types of sebum”. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, Applicant has argued in page 7 of the Request for Reconsideration (8/23/2005) that Fujii et al. “relates to nonwoven fabrics – not paper as in the claimed invention“. However, the limitation “paper” as described by Applicant’s Specification does not exclude nonwoven fabric. Applicant’s Specification discloses the fiber used for the material of the sebum absorbing paper includes not only wood pulp, but also cotton, acrylic fiber, rayon and silk and that one of the fibers can be the sole material used (Specification, Pg. 4).

Examiner has duly considered Applicant's arguments but deems them unpersuasive. Contrary to Applicant's arguments, pursuant to 35 USC 112, 2nd paragraph, Examiner has the right to require that Applicant claim what they consider to be the invention. Further, evidence that shows that a claim does not correspond in scope with that which applicant regards as applicant's invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant, *Solomon v. Kimberly-Clark Corp.*, 55 USPQ2d 1279 (Fed. Cir. 2000); *In re Prater*, 162 USPQ 541 (CCPA 1969). Further, Examiner has not admitted anything in the sentence bridging pages 2 and 3 of the March 30, 2005 action. In that sentence, Examiner is quoting from Applicant own brief as evidence that what Applicant considers to be the invention is not what is claimed.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Examiner withdraws the rejection of Claims 1-3 under 35 U.S.C. 102(f) because there is no evidence that the inventors of JP 2002330820 communicated the subject matter of the claimed invention to the present inventive entity prior to filing of the present application. However, because JP 2002330820 expressly discloses a sebum absorbing paper containing 10% hydroxyapatite and 10% talc, each with particle size of 3 microns, having a basis weight of 15 g/m² (See Table 2) which falls within the scope of the claimed invention and has the same assignee as the present application, there exists an ambiguity as to the issue of inventorship. Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent

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identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. 102(f). However, it is incumbent upon the inventors named in the application, in reply to an inquiry regarding the appropriate inventorship under subsection (f) to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter invented by the applicant rather than derived from the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. In re Katz, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship, and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the...inventor" of the subject matter disclosed in the article and claimed in the application). See MPEP Section 2137.

Examiner with draws the rejection of claim 1 is under 35 USC 102(f) over JP2003038248 for the same reasons as above. However, for the same reasons as above, since JP2003038248 expressly discloses a sebum absorbing paper containing 15 or 30 or 10% hydroxyapatite having a basis weight of 20, 20, and 5 g/m², respectively. (See Table 1) which falls within the scope of the claimed invention and has the same assignee as the present application, an ambiguity exists as to the issue of inventorship.

As such, Applicant is required to provide a Rule 132 affidavit providing factual evidence that inventors of the present application and not the inventive entities of the above Japanese Patent Applications are the inventors of the claimed invention.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

As indicated in MPEP Section 2137 and *In re Katz*, Examiner does have the right to require Applicant to file a declaration providing some evidence that the invention was not derived from another where although the difference in authorship alone is insufficient to reject under 102(f), the existence of the publication creates an ambiguity. The court in *In re Katz* accepted Applicant's declaration because it provided some evidence and was not "a mere pro forma restatement of the oath in his application." *Id.* at 18. As such, Applicant's oath which was filed with the application is not sufficient.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 393 723 in view of JP 11-137336, US Pat. Fujii et al. (US Pat. 5,041,252) and JP 63188628 or JP 63027411.

EP 0 393 723 discloses papers and nonwoven fabrics carrying or incorporating calcium phosphate compounds in the form of powders, granules or porous granules, having a particle size of 0.1 to 30 microns (Pg. 6, lines 7-15). It is disclosed that the paper contains 10 to 80% by weight of the calcium phosphate compound as a filler (Pg. 8, lines 43,44). It is disclosed that

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hydroxyapatite is a suitable calcium phosphate compound (Pg. 8, lines 44,45). It is disclosed that the calcium phosphate compound is generally solely used as a filler in the functional paper, however, if desired, it may be used together with conventional fillers such as talc (Pg. 9, lines 8-10). It is disclosed that preferably the functional paper shows a basis weight of 20 g/m² or more (Pg. 9, line 40). talc, where the paper preferably has a basis weight of 20 g/m², which is used as deodorants and absorbants (pgs. 5-10). It is disclosed that the functional paper can be used to adsorb any oil-soluble substances which could not be adsorbed with an activated carbon (Pg. 4, line 58, Pg. 5, line 1). It is disclosed that the functional paper can be used in diapers, sanitary napkins and pads for bedsores (Pg. 9, lines 45-50).

Fujii et al. disclose nonwoven fabric in the form of baby's napkin, women's sanitary napkin and toilet paper, which is not stimulative to the skin and has soft and good touch feeling, applied to the skin, in which inorganic materials, such as apatite and the like are added to improve the properties of the nonwoven fabric (Column 3, lines 9-16, Column 4, lines 52-67). It is disclosed that the nonwoven fabric can have a basis weight of 5 to 500 g/m², preferably 5 to 400 g/m², more preferably 10 to 300 g/m². (Column 4, lines 14-20).

JP 11-137336 discloses a paper used to absorb oil from the skin containing talc having an average particle size of 1.2 microns (Abstract).

JP 63188628 or JP 63027411 disclose that hydroxyapatite is used in cosmetic product to absorb oxidized lipids which absorption of oxidized lipids is effective in treating acne (Abstract).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a sebum absorbing paper used for applying to skin or for cleaning skin which contains 1-30% by weight hydroxyapatite and has a basis weight of 5 to 25 g/m².

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However, the prior art amply suggests the same as it is known in the art to use papers containing hydroxyapatite and talc as absorbants, papers containing talc are known to be used for absorbing oil from the skin and that hydroxyapatite is used in cosmetic products to absorb oxidized lipids. As such, one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that a paper containing hydroxyapatite and talc would be suitable for absorbing oxidized sebum from the skin because hydroxyapatite powders are known to be effective in absorbing oxidized lipids from the skin.

Examiner had duly considered Applicant's arguments but deems them unpersuasive.

Contrary to Applicant's arguments, Examiner has provided the motivation to modify the prior art and it clear what art would be modified. EP 0 393 723 discloses a paper containing hydroxyapatite and talc and the secondary reference each disclose modifications in the primary reference which would be known by one of ordinary skill in the art, i.e. Fujii et al. discloses motivation to use hydroxyapatite and that the basis weight of the nonwoven fabric can be varied as desired; JP 11-137336 disclose motivation to use talc as it absorbs oil of the skin; and JP 63188628 or JP 63027411 provide motivation to use hydroxyapatite as it absorbs oxidized lipids.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

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Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 208 USPQ 871 (CCPA 1981).

Applicant argues that EP'723 is not directed to a paper used for applying to the skin or for cleaning the skin. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In any case, EP'723 clearly discloses application on the skin, i.e. diapers, sanitary nakins and pads for bedsores (EP' 723, Pg. 9, lines 45-50).

Examiner cannot but agree with Applicant's assertion that EP'723 does not mention absorption of oxidized sebum, that JP'336 does not mention use of hydroxyapatite and that JP'628 or JP'411 do not mention the incorporation of the hydroxyapatite powder into or onto a paper. However, as indicated above, the rejection is based on a combination of references, as such, there is no requirement that EP'723, JP'336, JP'628 or JP'411 each recite every element of the claimed invention so long as the combined teachings of the references do suggest every element of the claimed invention. Contrary to Applicant's argument, the stated motivation above clearly indicates the rationale for concluding that one of ordinary skill in the art would combine prior art as above. Contrary to Applicant's arguments, Fujii et al. does not merely disclose implant materials having good compatibility with a living organism. There is no requirement that Fujii et al. disclose sebum absorption or selectively absorbing oxidized sebum. Applicant

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also argues that Fujii et al. relates to nonwoven fabrics not paper as in the claimed invention.

However, Applicant's paper product does not exclude nonwoven fabrics. Applicant's

Specification discloses the fiber used for the material of the sebum absorbing paper includes not only wood pulp, but also cotton, acrylic fiber, rayon and silk and that one of the fibers can be the sole material used (Specification, Pg. 4).

Applicant argues that the broad range in Fujii et al. of 5 g/m² –500 g/m² is vary different from 5/g/m² to 25 g/m², however, Applicant has admitted that EP'723 discloses a basis weight of the functional paper which falls within the claimed range of 5 to 25 g/m². The fact that the working examples in EP'723 and Fujii et al. disclose basis weight outside the claimed ranges do not overcome the rejection herein. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Further Fujii et al. also discloses a range of 10 to 300 g/m². As such, a range of 5-10 g/m² is clearly suggested by Fujii et al. As such, weight basis falling within the claimed range are clearly suggested by the prior art. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of "50 to 100 Angstroms" considered prima facie obvious in view of prior art reference teaching that "for suitable protection, the thickness of the protective layer should be

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not less than about 10 nm [i.e., 100 Angstroms]." The court stated that "by stating that 'suitable protection' is provided if the protective layer is about 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant's] claimed range.").

To the extent that Applicant is arguing that EP'723 is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, EP'723 is within the field of applicant's endeavor, i.e. papers having a suitable basis weight containing hydroxyapatite. Since EP'723 discloses a paper having an appropriate basis weight and including hydroxyapatite, EP'723 is within the field of Applicant's endeavor. See *In re Bigio*, 72 USPQ2d 1209 (CAFC 2004) (structural similarity between toothbrush and hairbrush was sufficient to conclude that toothbrush art was within the same field of endeavor).

Contrary to Applicant's arguments, the prior art discloses and/or suggests that papers containing hydroxyapatite powder can be applied to the skin and that the hydroxyapatite in the paper acts as an adsorbant. As such, based on the teachings of JP'628 and JP'411, one of ordinary skill in the art would expect that the hydroxyapatite contained in said papers when applied to the skin would act to absorb oxidized lipids from the skin.

Applicant argues that the limitation "selectively capable of absorbing oxidized sebum" means that the paper is capable of selectively absorbing oxidized sebum from other types of sebum based on the reading of the Specification. However, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In*

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re Van Geuns, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, Applicant argues that none of the applied art expresses any recognition for the problem of selectively absorbing oxidized sebum. However, Applicant's working examples do not show that hydroxyapatite absorb oxidized sebum in preference to other forms of sebum or even that hydroxyapatite absorbs lipid peroxide in preference to other lipids (See Specification, Table on Pg. 10). Also, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In *re Linter*, 173 USPQ 560 (CCPA 1972) ; In *re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.).

In this case, the prior art as whole, as indicated above, would motivate one of ordinary skill in the art to produce a paper have a weight basis falling within the scope of the claimed invention containing hydroxyapatite falling within the claimed amount, talc falling within the claimed amount and particle size, which paper would be able to absorb oxidized sebum. Applicant's argument relative to selectively absorbing oxidized sebum is merely an advantage which would flow naturally from following the teachings of the prior art.

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Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

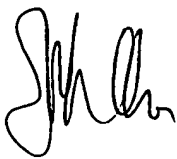
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FIC

November 14, 2005



**S. MARK CLARDY
PATENT EXAMINER
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